



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Our Case No. 12965US03)

In The Application Of:)

Marshall et al.)

Serial No.: 10/648,463)

Filed: August 26, 2003)

Examiner: V. Bali)

Group Art Unit: 2623)

For: METHOD FOR GENERATING A)
UNIQUE AND CONSISTENT SIGNAL)
PATTERN FOR IDENTIFICATION OF)
AN INDIVIDUAL)

CERTIFICATE OF MAILING

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March 2, 2005

By: *Jan D. Kueper*

Reg. No.: 30,121

RESPONSE

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action of September 13, 2004. Claims 1, 2, 13, 14 and 16 are at issue.

The rejection of claims 1, 2, 13, 14, and 16 as obvious under 35 U.S.C. §103 in view of Hill 4,393,366 is respectfully traversed.

Claims 1 and 2 specify "finding a boundary of the optic disk in the image represented by said pixel data." Even though the Examiner admits that Hill does not disclose this claimed step, the Examiner contends that because "in figure 2, numerical 64 shows that there exists some sort of boundary around the optical disk...it would have been obvious to one of ordinary skill in the art at the time of invention to simply modify the reference Hill to find the boundary of the optic disk to get the pattern of the optic nerve in order to obtain the unique feature of an individual." However,

the dashed circle 64 is not a boundary of the optic disk as required by the claims but is clearly outside of and away from the optic disk as shown in figure 2 of Hill. In fact, Hill describes “the dashed circle 64” as illustrating “a locus of points illuminated on a retina” at col. 4, ln. 58 – col. 5, ln. 2 but does not describe any relation of that “locus of points” to the optic disk.

There is no support whatsoever for the proposition that it would be obvious to one of ordinary skill in the art to modify Hill to find the boundary of the optic disk as claimed. Hill, in fact suggests the opposite, i.e. that it is not necessary to find the boundary of the optic disk in order to obtain a signal pattern that is unique to an individual because Hill generates a signal pattern to identify an individual without first finding the boundary of the optic disk. The Examiner contends that it would be obvious to modify Hill to add the step of finding the optic disk because that additional step will provide an apparatus that will identify an individual with increased speed and reliability. But no such teaching is found in Hill whatsoever. Because there is nothing in Hill to suggest the Examiner’s modification to Hill, it is clear that a hindsight analysis is being employed to reject the claims. In particular, it appears that the teachings of the very patent application at issue are being used as a suggestion to modify Hill in order to reject the claims. It is completely improper to use the teachings of a patent application itself to reject the very claims of the patent application. Since Hill does not disclose or suggest in any way finding the boundary of the optic disk as recited in claims 1 and 2, Hill does not and cannot render these claims obvious under 35 U.S.C. §103. Therefore, claims 1 and 2 are believed to be allowable under 35 U.S.C §103.

Claims 13, 14 and 16 specify “determining a location of the optic disk in the image from said pixel data” and “fitting a contour approximating a shape of at least a portion of the optic disk onto the image of the optic disk represented by said pixel data.” Hill does not disclose or suggest either of these steps. Specifically, Hill does not use pixel data to determine the location of the optic

disk as claimed. Hill does not even determine a location of the optic disk. Moreover, instead of fitting a contour onto the image of the optic disk represented by said pixel data, Hill illuminates points on the retina itself outside of the optic disk. As is clear from figure 2, the dashed circle 64 is not on the optic disk. More importantly, however, the circle 64 is not being fitted onto an image of the optic disk represented by pixel data as claimed. Because Hill does not disclose or suggest in any way the claimed steps of determining a location of the optic disk in the image from the pixel data and fitting a contour approximating a shape of at least a portion of the optic disk onto the image of the optic disk represented by the pixel data, Hill cannot make obvious claims 13, 14 and 16 under 35 U.S.C. §103. Claims 13, 14 and 16 are therefore believed to be allowable under 35 U.S.C. §103.

In view of the above, claims 1, 2, 13, 14, and 16 are believed to be allowable under 35 U.S.C. §103. Reconsideration and allowance is respectfully requested.

Respectfully submitted,

Dated: March 2, 2005

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